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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,686	03/19/2004	Frank Talarico JR.	AUTUS.001A	8174
20995	7590	10/20/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			KIM, AHSHIK	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			2876	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/804,686	Applicant(s) TALARICO, FRANK	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/19/04 (*initial filing of application*).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04/04</u>
<u>5/7/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status Letter

1. Receipt is acknowledged of the status letter filed on September 19, 2005. This is the first
5 Office Action in response to initial filing of application.

Continuation Data

2. Acknowledged this application claims the benefit of provisional application Serial No.
60/456,991 filed on March 21, 2003.

10

Claim Objections

3. Claims 1 and 12 are objected to because of the following informalities:

Re claims 1 and 12: in claim 1, in identifying steps in the method, (a) (b) (c) were
used whereas in claim 12, (i) and (ii) are used. Unless they carry special significance, step
15 identifiers should be consistent. In fact, in claim 12, (i) and (ii) were used **in duplicate** and it is
unsure whether they are representing the steps in the method or designated for the entities in the
claim (i.e., member and stored-value card). Shouldn't claim 12 be the same claim as 1, but
pertain to the system instead of method? If so, claim 12 should be virtually identical to the claim
1 except for the preamble.

- 20 4. Claim 6 is objected to because of the following informalities:

Re claim 6: it is unclear the steps (b) and (d) and (b) refereed in the claim are refereeing
back to the steps in claim 1 or the own steps of claim 6.

Appropriate explanations/correction is respectfully suggested.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

5 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite
for failing to particularly point out and distinctly claim the subject matter which applicant
10 regards as the invention.

It is difficult to contemplate exactly what is claimed in claim 6. Claim 7 is rejected
because claim 7 is dependent on claim 6.

Examiner respectfully requests Applicant to point out in the specification where the
subject matter on claim 6 and 7 are disclosed. Examiner respectfully requests the applicant to
15 amend claim 6 including sub-steps so that the content is clearly conveyed to others.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

20 A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
25 subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2876

8. Claims 1, 2, 4, 9, and 12-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Parfait et al. (US 2003/007615 A1, hereinafter "Parfait").

Re claims 1, 9, and 12, Parfait discloses a method for facilitating donation from a population (see abstract) wherein each member is provided with a prepaid card (stored-value
5 card) (abstract; paragraphs 0005 and 0007). The donation can be made on a cyclical basis (see paragraph 0025) wherein the users can set the parameters such as charity recipient and amount. The prepaid card can be recharged (see paragraph 0046). So, based upon available balance, and scheduled donation parameters, the fund can be donated to the charity on regular basis.

Re claims 2 and 13, the donation can be set as a percentage of the transaction (see
10 paragraph 0007), which includes recharging of the card.

Re claim 4, the charitable organization includes a humanitarian organization (paragraph 0007), which would include a religious institution.

Re claims 14-17, the member account can be on a prepaid card or in the server (see paragraph 0004). Although not explicitly stated, it is the Examiner's view that the activity of
15 spending, donating and recharging would have to be accounted to show correct balance of the card.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
20 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
25 manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parfait et al. (US 2003/007615 A1) in view of Phillips (US 2003/0154163 A1, hereinafter "Phillips").

The teachings of Parfait have been discussed above. Parfait, however, fails to
5 specifically teach or fairly suggest that the beneficiary is a school.

Phillips teaches a system and the method for facilitating a donation utilizing pre-paid card (see abstract) wherein the beneficiary includes a school (see paragraphs 0007 and 0093).

In view of Phillips' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further include a school as a charity recipient. School often
10 uses scripts and other fund-raising activity to generate funding source. Alumnus are regularly solicited for donations to their alma-mata. Accordingly, allowing the schools to be a beneficiary is well within with modification one ordinary skill in the art would contemplate.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parfait et al. (US
15 2003/007615 A1) in view of Hardesty (US 6,105,865, hereinafter "Hardesty").

The teachings of Parfait have been discussed above. Parfait, however, fails to specifically teach or fairly suggest that the beneficiary is a saving account of self. school.

Hardesty teaches a card transaction system when a consumer purchases products or services and a portion of credit/transaction is accumulated toward the consumer's retirement
20 account or savings account (col. 1, lines 5+; col. 3, lines 41+).

In view of Hardesty's it would have been obvious to an ordinary skill in the art at the time the invention was made to further include one's saving account or retirement account as a

Art Unit: 2876

charity recipient. By using the card, saving or saving toward retirement grows, and he/she may not have to allocate additional resources toward savings.

12. Claims 8, 10, 11, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable
5 over Parfait et al. (US 2003/007615 A1) in view of Hermreck et al. (US 2002/0133436 A1, hereinafter "Hermreck").

The teachings of Parfait have been discussed above. Parfait, however, fails to specifically teach or fairly suggest that the system generates various reports for the participants.

Hermreck discloses a system and method for recording and tracking charitable donations
10 over a period of time (see abstract). The system provides necessary web interfaces (figures 3-23), which includes reports (see figure 17) by charity, monthly donation report, and item donation report for IRS reporting, etc.

In view of Hermreck's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further employ well-known internet interface and reporting
15 functions in order to keep the donor abreast of his/her donations. By providing up-to-date information, the participants can better manage their donation and personal finance. Moreover, web-interface provides a resource where donation can be made virtually anywhere and any time.

20

Additional Remarks

13. The lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e., even though claims 6 and 7 are rewritten or amended to overcome the

Art Unit: 2876

rejection under 35 U.S.C. 112 as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

Conclusion

5 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Major (US 2002/0174063); Hansen et al. (US 2003/0055780); Branch (US 2003/0167177); Barton (US 6,64,533); Hovakimian (US 5,466,919) disclose various donation system. Applicant is respectfully suggested to carefully review these references.

10 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

30 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

35 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 10/804,686

Page 8

Art Unit: 2876

A handwritten signature in black ink, appearing to read 'Ahshik Kim', with a stylized flourish at the end.

Ahshik Kim
Primary Examiner
Art Unit 2876
October 12, 2005